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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,632	09/08/2003	Marc Brian Wisnudel	122623-1	9463
31554	7590	04/06/2006		
CARTER, DELUCA, FARRELL & SCHMIDT, LLP 445 BROAD HOLLOW ROAD SUITE 225 MELVILLE, NY 11747			EXAMINER ANGEBRANDT, MARTIN J	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/657,632	WISNUDEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Martin J. Angebranndt	1756	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 1/10/05 & 12/11/03.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-65 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-65 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All    b) ☐ Some \* c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
       Paper No(s)/Mail Date 1/10/05 & 12/11/03.

4) ☐ Interview Summary (PTO-413)  
       Paper No(s)/Mail Date. \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 48,49 and 54-65 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Wisnudel et al. '051.

See the example in column 22, (parts, A,B and C are mixed) and applied in examples following it.

4. Claims 48,49 and 54-65 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Olson et al. '013.

See the examples composition used in example 5. Examples 7 and 9 also use a TIPSOCLMB containing adhesive.

5. Claims 1-5,7,8,10-12 and 16-18 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Lawandy et al. '933.

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Lawandy et al. '933 describes the solutions polyhydroxystyrene, ethanol, crystal violet lactone and other solvents. The coatings would appear to be applied in the manner shown with respect to figures 4A and 4b. Useful substrate materials include polycarbonate (11/45). The substrate may be aluminum. (6/29+)

The term "carrier" is read broadly to embrace solvents and the like. If the applicant was to have the claims recite "a polymeric carrier, then this prior art reference would not anticipate the claims. Claims 2 and 5-7 do not require that the further modified polymers be used in the composition.

6. Claims 1,8,10-12 and 16-18 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Dominick et al. '686.

See composition disclosed at column 3/lines 66-col. 4/line 4, which uses polyvinyl alcohol.

7. Claims 1,8,10-12 and 16-18 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Fechter '761.

See composition disclosed at column 3/lines 64-68.

8. Claims 1,8,10-12 and 16-21 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Cespon '671.

See composition 3 disclosed in column 3 at lines 38-44.

9. Claims 1,8,10-12 and 16-21 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Kreig-Kowald '499

See example 2, which includes hydroxypolystyrene and benzoyl leouco methylene blue [0040].

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10. Claims 1-5,7,13,16-21 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Bhatt et al. '191.

Bhatt et al. '191 teach compositions including a leuco dye, polyhydroxystyrene, and another binder (table 1). The use of polymeric acidic developers as preferable to phenol derivatives and other small compounds, due to the increased stability. [0011-0013]. The use of linear, branched and co-polymers of polystyrene are disclosed. [0019-0021]. The use of phenothiazine compounds is disclosed. [0018].

11. Claims 1-7 and 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatt et al. '191.

It would have been obvious to one skilled in the art to modify the cited examples by using other preferred polymeric developers, such as the co-polymers of polystyrene with acrylic monomers and/or branched polystyrene disclosed by Bhatt et al. '191 with a reasonable expectation of forming a useful optical recording medium with limited replay ability.

12. Claims 1-7,10-14 and 16-21 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Gotoh et al. '593.

Gotoh et al. '593 teach a mixture of leuco dyes, methyl cellulose, and polyvinyl alcohol. (table in columns 31-32, which are mixed together)

13. Claims 1-5,7-21,23,24,26-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezbiansky et al. '859.

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See claims 1,2,6 and 13 (polyvinylphenol recited in claim 13 is polyhydroxystyrene)

14. Claims 1-5,7-9, 13-21,23,24,26-31 and 35-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisnudel et al. '931.

See claims 1,19 and 21 (claim 21 recites is polyhydroxystyrene)

15. Claims 1-5,7-9, 13-21,23,24,26-31 and 35-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisnudel et al. 571.

See claims 1,5,8 and 28 (claims 8 and 28 recites is polyhydroxystyrene).

16. Claims 1-5,7-9, 13-21,23,24,26-31 and 35-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindholm et al. '188.

See claim 29 and claim 1. See also the adhesive composition discussed at [0187-0194].

17. Claims 1-8,10-12 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreig-Kowald '499, in view of Bhatt et al. WO 02/096664.

Bhatt et al. WO 02/096664 teaches the use of polymeric acidic developers as preferable to phenol derivatives and other small compounds, due to the increased stability. (4/23-5/7). The use of linear, branched and co-polymers of polystyrene are disclosed. (5/11-7/8)

It would have been obvious to one skilled in the art to modify the cited examples of Kreig-Kowald '499 by using other preferred polymeric developers, such as the co-polymers of polystyrene with acrylic monomers and/or branched polystyrene disclosed by Bhatt et al. WO 02/096664 with a reasonable expectation of forming a useful optical recording medium with limited replay ability.

18. Claims 1-8,10-12 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. '933, in view of by Bhatt et al. WO 02/096664.

It would have been obvious to one skilled in the art to modify the cited examples of Lawandy et al. '933 by using other preferred polymeric developers, such as the co-polymers of polystyrene with acrylic monomers and/or branched polystyrene disclosed by Bhatt et al. WO 02/096664 with a reasonable expectation of forming a useful optical recording medium with limited replay ability.

19. Claims 48-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisnudel et al. '051 or Olson et al. '013, in view of Bhatt et al. WO 02/096664.

It would have been obvious to one skilled in the art to modify the cited examples of Wisnudel et al. '051 or Olson et al. '013 by using other preferred polymeric developers, such as the co-polymers of polystyrene with acrylic monomers and/or branched polystyrene disclosed by Bhatt et al. WO 02/096664 with a reasonable expectation of forming a useful optical recording medium with limited replay ability.

20. Claims 1-21 and 23-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezbiansky et al. '982, Ezbiansky et al. '859 or Olson et al. '206, in view of Bhatt et al. WO 02/096664.

Ezbiansky et al. '982 teaches optical recording media incorporating a replay limiting layer, containing methylene blue, a polymeric binder of methylmethacrylate/methacrylic acid and a polyhydroxy compound in the examples 1-6.

Ezbiansky et al. '859 teaches optical recording media incorporating a replay limiting layer, containing methylene blue, a polymeric binder of methylmethacrylate/methacrylic acid and a polyhydroxy compound in the examples 1-6.

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Olson et al. '206 teaches optical recording media incorporating a replay limiting layer, containing methylene blue, a polymeric binder of methylmethacrylate/methacrylic acid and a polyhydroxy compound in the examples 1-6.

It would have been obvious to one skilled in the art to modify the cited examples of Wisnudel et al. '051 or Olson et al. '013 by using other developers which yield improved stability, such as the co-polymers of polystyrene with acrylic monomers, linear, and/or branched polystyrene disclosed by Bhatt et al. WO 02/096664 with a reasonable expectation of forming a useful optical recording medium with limited replay ability.

21. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezbiansky et al. '982, Ezbiansky et al. '859 or Olson et al. '206, in view of Bhatt et al. WO 02/096664, further in view of Lindholm et al. '188.

In addition to the basis provided above, the examiner holds that it would have been obvious to use other methylene blue analogs, such as that identified in claim 1 of Lindholm et al. '188, in place of methylene blue with a reasonable expectation of forming a useful limited replay optical recording medium. There is no evidence of record showing an advantage when using the compounds recited in claim 22 as the reactive material.

22. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).



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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

23. Claims 1-65 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6925051. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant applicant include both the media and the coating formulation applied as a film/coating and claims 5 and other specifically describe a polyhydroxystyrene.

24. Claims 1-5,7-9, 13-21,23,24,26-31 and 35-65 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 and 29 of copending Application No. 10/651627 (US 2004/0137188). Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the reactive adhesive layers and recite the methylene blue analog shown in claim 1 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kato et al. '212 (4/49-63), JP 06-032060 (abstract) and Hayakawa et al. '345 (14/48-64)

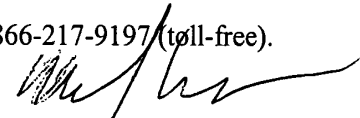
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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebrannndt whose telephone number is 571-272-1378.

The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Martin J. Angebrannndt  
Primary Examiner  
Art Unit 1756

03/31/2006